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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/417,739	10/14/1999	JEROME D. BOSS	MSFT-0097/14	7856

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EXAMINER

JACOBS, LASHONDA T

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 10/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/417,739

Applicant(s)

BOSS ET AL.

Examiner

LaShonda T. Jacobs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 14 October 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 21-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 3
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121.
 - I. Claims 1-15, and 16-20, drawn to a method for recording network transactions, classified in class 709, subclass 224.
 - II. Claims 21-31, and 32-36, drawn to a method for simulating a user network transactions, classified in class 703, subclass 21.
2. The inventions are distinct, each from another because of the following reasons:

Inventions I and II are related as sub-combinations disclosed as usable together in a single combination. The sub-combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as in a method where the user network transactions are simulated (as set forth in invention II). See MPEP § 806.05(d).
3. During a telephone conversation with Peter Ullman on Thursday, October 10, 2002, a provisional election was made without traverse to prosecute the invention Method and System for Recording and Replaying Transactions claims 1-15, and 16-20. Affirmation of this selection must be made by applicant in replying to this Office Action. Claims 21-31, and 32-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "28" and "50" have both been used to designate Floppy Drive. A proposed

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drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: note reference numerals 55, 56, and 62 in Fig. 1, reference numeral 160 in Fig. 5, reference numeral 721 in Fig. 7B, reference numeral 807 of Fig. 8, reference numeral 160 in Fig. 11, and reference numeral 1206 in Fig. 12. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: note reference numeral 160 in Fig. 3, reference numeral 160a in Fig. 5, reference numerals 707, 401, 800, 410a, and 501 in Fig. 8, and reference numeral 160a in Fig. 11. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to because Figures 6 and 9 are not clearly referred to in the specification along with their reference numerals. Examiner suggest that applicant change the following: "Web browser 180 has an Internet options dialog box 600, whereby a user may configure various aspects of web browser 180." to "Web browser 180 has an Internet options dialog box 600 (see Figure 6), whereby a user may configure various aspects of web browser 180." (see pg. 13, lines 1-3). "Web page 410a may contain hyperlinks 411a-411c to other pages identified by their URLs 401a-401c." to "Web page 410a (see Figure 9) may contain hyperlinks

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411a-411c to other pages identified by their URLs 401a-401c” (see pg. 18, lines 4-5). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

8. Claim 13 and 16 are objected to because of the following informalities: the word MICROSOFT in claim 13 is spelled incorrectly.

As per claim 16, the word couplable is not a word. Examiner suggests that the word couplable be replace with the word coupled. Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 13 uses the trademark “MICROSOFT WINDOWS”. The use of a trademark within a claim is considered to be indefinite since the material or composition of a trademark refers to can be changed at the owner’s discretion with the trademark remaining the same. The applicant should replace the trademark with a generic term.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

11. Claims 1-3, 5-6, 10-11, and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Bryant.

As per claim 1, Bryant discloses a method and system for recording network transactions, comprising the acts of:

- coupling to a client object by the way of a proxy server (monitor) interface of said client object (see abstract, col. 3, lines 59-61 and col. 10, lines 15-16);
- receiving a client request destined for said network (col. 3, lines 34-36);
- recording selected information indicative of said client request (col. 2, lines 8-12, and col. 3, lines 62-66); and
- transmitting said client request onto said network (col. 3, lines 34-36, and col. 4, lines).

As per claims 2 and 17, Bryant discloses:

- wherein said network comprises the Internet (col. 3, lines 1-3).

As per claims 3 and 18, Bryant discloses:

- wherein said client object comprises a browser (col. 3, lines 5-9).

As per claim 5, Bryant further discloses:

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- receiving a response to said request from said network (col. 3, lines 34-36, and col. 4, lines 50-56); and
- transmitting said response to said client object (col. 3, lines 34-36, and col. 4, lines 54-56).

As per claim 6, Bryant further discloses:

- the act of recording said response (col. 5, lines 3-6).

As per claim 10, Bryant discloses:

- wherein said acts are performed by a computer, and wherein said client object comprises a process running on said computer (col. 2, lines 6-8, and col. 11, lines 58-59).

As per claim 11, Bryant discloses:

- wherein said transmitting acts transmit the received client requests to said network without alteration (col. 4, lines 50-56).

As per claim 14, Bryant discloses:

- wherein said client object is configured to use a server machine as a proxy server, and wherein said act of transmitting comprises sending said client request to said server machine (at least implicitly) (col. 6, lines 43-65, and col. 7, lines 1-25).

As per claim 15, Bryant discloses:

- a computer-readable medium containing computer-executable instructions (col. 10, lines 64-67, and col. 11, lines 1-6).

As per claim 16, Bryant discloses:

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- a first interface couplable to a client object, whereby said interface receives requests destined for said network from said client object (at least implicitly) (col. 3, lines 5-8 and lines 49-61);
- a recorder object in communication with said first object for receiving said requests by way of said first interface (col. 4, lines 66-67 and col. 5, lines 1-6), and said recorder object creating a record comprising a representation of said requests (see Fig. 2, col. 3, lines 62-67, col. 4, lines 1-3, and col. 5, lines 3-6); and
- a second interface couplable to said network (at least implicitly) (col. 2, lines 66-67, col. 3, lines 1-5, lines 14-26), said second interface being in communication with said recorder object wherein said recorder object transmits said request to said network by way of said second interface (col. 4, lines 50-56).

As per claim 19, Bryant discloses:

- wherein the second interface receives responses destined for said client object originating from said network (see Fig.2, and col. 4, lines 50-56),
- wherein said recorder object is in communication with said second interface for receiving responses by way of said second interface (see Fig. 2, and col. 4, lines 50-56); and
- wherein said first interface is in communication with said recorder object whereby said recorder object transmits said response to said client by way of said first interface (see Fig. 2, and col. 4, lines 50-56).

As per claim 20, Bryant discloses:

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- wherein said recorder object creates a record of said responses (see Fig. 2, col. 5, lines 2-6, and col. 12, lines 58-60).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 4, 7-8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant in view of Dobbelstein.

As per claim 4, although Bryant shows substantial features of the claimed invention (discussed above), it fails to explicitly disclose:

- the act of simulating a user interaction by retransmitting said client request.

However, the use and advantages of simulating a user interaction by retransmitting said client request is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Dobbelstein (col. 1, lines 42-50, and col. 7, lines 18-27).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement the act of simulating a user in Bryant's method because this would allow multiple threads to be created, each which act like a network client and interacts with a server as a separate user.

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As per claim 7, although Bryant shows substantial features of the claim invention (discussed above), it fails to explicitly disclose:

- a second client

However, the use and advantages of having a second client connected to a network is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Dobbelstein (col. 2, lines 60-62, col. 7, lines 18-27, and col. 13, lines 54-59).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate a second client in Bryant's system allowing requests to process in a timely manner with a little delay between the requests.

As per claim 8, Bryant discloses:

- wherein said response is a web page including a plurality of hyperlinks (col. 5, lines 29-34, col. 7, lines 45-48 and lines 66-67, and col. 8, lines 1-2); and
- wherein said function takes into account the relative location of one said hyperlinks on said web page (at least implicitly) (col. 7, lines 66-67, col. 8, lines 1-2 and lines 7-16).

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant in view of Dobbelstein and in further view of Wang.

As per claim 9, although Bryant and Dobbelstein show substantial features of the claim invention (discussed above), it fails to explicitly disclose:

- recording time between client requests.

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However, the use and advantages of recording time between requests is well known to one skilled in the relevant art at the time the invention was made as evidenced by the teachings of Wang (at least implicitly) (col. 2, lines 6-13).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the step of recording time between requests in Bryant in view of Dobblesstein system to monitor the performance between the client and the server to ensure that requests are being process in a timely and sufficient manner.

15. Claims 12 and 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bryant in view of Salas et al. (hereinafter, "Salas", 6,233,600).

As per claim 12, Bryant discloses:

- wherein said act of coupling comprises modifying said file (col. 7, lines 1-25).

However, Bryant fails to explicitly disclose:

- wherein proxy server settings of said client object are located in a file.

However, the use and advantages for storing proxy server settings in file is well known to one skilled in the relevant art at the time the invention was made as evidence by the teachings of Salas.

In an analogous art, Salas discloses a collaborative work environment which clients receive data objects from one or more servers comprising:

- wherein the proxy server settings of said client object are located in a file (col. 14, lines 5-9, and lines 17-24).

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Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the proxy server settings of said client object are located in a file in Bryant's system allowing the client/user to change the settings of the proxy server in order to speed up the processing of requests.

As per claim 13, Bryant discloses:

- wherein said method is performed in a MICROSOFT WINDOWS operating system environment (col. 3, lines 28-33); and
- wherein said file comprises the MICROSOFT WINDOWS operating system registry (at least implicitly)(col. 3, lines 28-33).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Pat. No. 6,253,248 to Nakai et al.

U. S. Pat. No. 5,809,250 to Kisor

U. S. Pat. No. 6,401,125 to Makarios et al.

U. S. Pat. No. 6,078,956 to Bryant et al.

U. S. Pat. No. 6,411,998 to Bryant et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaShonda T. Jacobs whose telephone number is 703-305-7494.

The examiner can normally be reached on 8:30 AM - 5:00 PM.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

LaShonda T. Jacobs
Examiner
Art Unit 2157

ltj
October 15, 2002



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